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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------------|
| 10/501,894 | 08/23/2004 | Ernst Brunbauer | 24371/3 | 9010 |
| 71130 7590 08/09/2007 SEYFARTH SHAW LLP WORLD TRADE CENTER EAST TWO SEAPORT LANE, SUITE 300 BOSTON, MA 02210-2028 | | | EXAMINER HALPERN, MARK | |
| | | | ART UNIT 1731 | PAPER NUMBER |
| | | | MAIL DATE 08/09/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/501,894 | Applicant(s) BRUNBAUER ET AL. | |
| | Examiner Mark Halpern | Art Unit 1731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- 1) Acknowledgement is made of Amendment received 8/3/2007.

Claims 1-11 are amended and claim 12 is cancelled.

Specification

- 2) The content of the Specification is not complete; the Specification does not include a Brief Description of Drawings.

Inserting the Brief Description of Drawings into Page 1, line 1, as suggested in the Amendment of 8/3/2007, is not possible, since that is in the middle of section titled BACKGROUND OF INVENTION.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3) Claims 1-4, 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ishino (5,849,153).

Claims 1-4: Ishino discloses the formation of a paper sheet and the printing of a coating layer made of water soluble polymer solution (Abstract and cols. 3-4). The polymer includes polysaccharides (col. 9, lines 1-37). The printing is done at 90 degrees C (Example 1). The printing is done before the paper is put away for storage or in the least it would have been obvious to one skilled in the art at the time the invention was made that the printing be performed before roll-up and storage. The paper is a cigarette paper (Abstract).

Claim 6: paper basis weight is 15-80 g/m² (col. 7, lines 50-55).

4) Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishino in view of Kraker (6,779,530). Ishino is applied as above for claim 1, Ishino fails to disclose the printing solution viscosity. Kraker discloses smoking article paper with reduced ignition wherein the claimed printing solution viscosity is disclosed. Ishino and Kraker disclose each element of the invention. One of ordinary skill in the art could have combined the elements by known methods since the combination of Ishino and Kraker is a combination of known methods, and each element combined would have performed the same function as it did separately, and thus one of ordinary skill in the art would have recognized that the results of the combination were predictable.

5) Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishino in view of Hamajima (5,496,626).

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Claim 7: Ishino is applied as above for claim 1, Ishino fails to disclose the paper absorption rate. Hamajima discloses a paper having an absorption rate of less than 30 mm after 10 minutes (Hamajima, col. 7, lines 43-55). Ishino and Hamajima disclose each element of the invention. One of ordinary skill in the art could have combined the elements by known methods since the combination of Ishino and Hamajima is a combination of known methods, and each element combined would have performed the same function as it did separately, and thus one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 8: Hamajima discloses a paper having an absorption rate of less than 30 mm after 10 minutes (Hamajima, col. 7, lines 43-55).

6) Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishino in view of Hamajima and further in view of Kraker.

Claim 9: Ishino in view of Hamajima is applied as above for claim 8, Ishino in view of Hamajima fail to disclose the roller serving as a backing support. Roller backing is disclosed by Kraker in Figure 3. Ishino, Hamajima and Kraker disclose each element of the invention. One of ordinary skill in the art could have combined the elements by known methods since the combination of Ishino, Hamajima and Kraker is a combination of known methods, and each element combined would have performed the same function as it did separately, and thus one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 10: entire width of paper is coated.

Claim 11: reduced ignition proclivity is disclosed (Kraker, Title)

Response to Amendment

- 7) Claim 3 rejection under 35 U.S.C. 112, second paragraph, is withdrawn in view of amended claims.
- 8) Claims 1-4, 6, 12 rejection under 35 U.S.C. 102(b) as being anticipated by Ishino is withdrawn in view of amended and cancelled claims.
- 9) Claims 5, 7 rejection under 35 U.S.C. 103(a) as being unpatentable over Ishino is withdrawn, in view of amended claims.
- 10) Claims 8-11 rejection under 35 U.S.C. 103(a) as being unpatentable over Ishino in view of Kraker, is withdrawn in view of amended claims.
- 11) Inserting the Brief Description of Drawings into Page 1, line 1, as suggested in the Amendment of 8/3/2007, is not possible, since that is in the middle of section titled BACKGROUND OF INVENTION.
- 12) Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

- 13) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone no. is 571-272-1190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Halpern/
Primary Examiner
Art Unit 1731